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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,954	10/02/2000	Sunil K. Rao	IPHLNZ00202	3145

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EXAMINER	
FADOK, MARK A	

ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/677,954	RAO ET AL.	
	Examiner	Art Unit	
	MARK FADOK	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-51 and 53-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-51 and 53-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application.
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 5/28/2010, which was received 11/29/2010. Acknowledgement is made to the amendment to claims 48,50,51, the cancelation of claims 1-47,52 and the addition of claims 54-62. The examiner has carefully considered applicant's remarks and amendment and finds them persuasive however after further search and consideration the following new ground of rejection modified as necessitated by amendment follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 48-51,53-56,58,59,61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) and further in view of Bednarek (US 6,956,868).

In regards to claims 48-51, Treyz teaches all the features of the instant claims except as follows:

Treyz teaches using a scanner to scan products and purchase them utilizing the barcode information provided from the scanner transmitted to the central computer (FIG

4,17,21,27,72,118, abstract and summary). Treyz teaches executing a transaction in response to a received transaction request, including communicating with at least one server received from the mobile device and comprising automatic payment using the bar code reader device (Treyz FIG 28, 60 (item 626 and FIG 110), but does not specifically mention automatically entering an item in an inventory database as sold, enabling the item to be removed from a store. Trotta, Jr., teaches automatically entering an item in an inventory database as sold, enabling the item to be removed from a store (FIG 2). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Treyz automatically entering an item in an inventory database as sold, enabling the item to be removed from a store, because this will eliminate the lengthy and sometimes objectionable checkout queues in which the customer must wait, thus saving time for the customer (Trotta col 2, lines 35-40).

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board

decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Wherein the transaction execution request can be transmitted from a remote position and local position relative to the store (Treyz, FIG 10).

The combination of Treyz and Trotta teach submitting queries, but does not specifically mention “setting up at least one customized search engine table to conduct a search by selecting a parameter of interest from the table” or (wherein the server uses a lookup table and a stored user profile to set an environment specific to the user for the selected transaction request”. Bednarek teaches “setting up at least one customized search engine table to conduct a search by selecting a parameter of interest from the table” (col 69, lines 55-65) or “wherein the server uses a lookup table and a stored user profile to set an environment specific to the user for the selected transaction request” (FIG 9-1, creating your own incentive program)

In regards to claim 53, The combination of Treyz and Trotta Jr. teach wherein the automatic payment includes payment directly charged to an account maintained by file user with a service provider or payment by debiting an amount from an account maintained by the user within the mobile device (Treyz, FIG 28, 60 (item 626), and FIG 110).

In regards to claim 54, the combination of Treyz, Trotta Jr., and Bednarek teaches wherein the mobile device further comprises a user customizable list in the

form of a configurable list which is imputed on a PC or other convenient input means and down loaded onto the mobile device (Bednarek, col 60, lines 4-21, col 80, lines 22-34).

In regards to claim 55, the combination of Treyz, Trotta Jr., and Bednarek teaches wherein a local server or internet server is programmed to learn search needs and patterns to artificially learn the user's search behavior, preferences and search patterns and generate a customized and dynamically responsive artificial intelligence search engine function (Bednarek,col 80, lines 22-34).

In regards to claim 56, the combination of Treyz, Trotta Jr., and Bednarek teaches wherein value optimization factors of a user are inputted to generate an algorithm to drive individual satisfaction on all factors (Bednarek, col 18, line 15-34).

In regards to claim 58, the combination of Treyz, Trotta Jr., and Bednarek teaches auto adjusting and decreasing store inventory for a sold item and automatically notifying a supplier, placing an order for the item and scheduling delivery of the item (Trotta, col 5, lines 30-45).

In regards to claim 59, the combination of Treyz, Trotta Jr., and Bednarek teaches updating the user profile with information relating to the user (Bednarek, col 37, line 66-col 38, line 7).

In regards to claim 61, the combination of Treyz, Trotta Jr., and Bednarek teaches wherein flags may be set for regularly interrogating a site and notifying the user of an event triggering a need which has been expressed by the user (Bednarek, col 37, line 66-col 38, line 7).

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) in view of Bednarek (US 6,956,868) and further in view of Brophy (US PG PUB 20030055974) .

In regards to claim 57, the combination of Treyz, Trotta Jr., and Bednarek teaches transforming a coded message sent from a cell phone into a script that an agent can understand, but does not specifically mention the parsing into a more suitable form for processing, includes language conversion. Brophy teaches parsing a message and converting it into a different language (Brophy 20030055974, Para 0065). It would have been obvious to a person having ordinary skill in the art a the time of the invention to include in Brophy, parsing a message and converting it into a different language as is taught by Brophy, because this will allow a wider use of agent experts that may answer

question from people of different languages thus increasing the scope of what an agent can handle.

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) in view of Bednarek (US 6,956,868) and further in view of Tanaka (US 7,008,456) .

In regards to claim 60, the combination of Treyz, Trotta Jr., and Bednarek teach the use of RFID tags, but does not specifically mention a zone controller causes an audible or other notification to a sales clerk or vendor if a customer attempts to remove or add an item from a predefined control zone under the supervision of the zone controller. Tanaka teaches sending of an alarm when a person tries to leave a store with an RFID tag attached to a product (Tanaka, col 1, lines 23-45). It would have been obvious to a person having ordinary skill in the art a the time of the invention to include in Treyz, Trotta Jr., and Bednarek a zone controller causes an audible or other notification to a sales clerk or vendor if a customer attempts to remove or add an item from a predefined control zone under the supervision of the zone controller, because this was well known means for reducing theft at department stores.

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) in view of Bednarek (US 6,956,868) and further in view of Davis et al (US 6,965,682) .

In regards to claim 62, the combination of Treyz, Trotta Jr., and Bednarek teach providing information including the images of the user to a server and/or a third party to assist in the purchasing process, Treyz and Bednarek also teach the use of a camera on a cell phone for capturing images, but does not specifically mention that the images of the goods are captured. Davis teaches capturing the image of a product and sending it to a server or third party (Davis et al, col 2, lines 20-45). It would have been obvious to a person having ordinary skill in the art a the time of the invention to include in Treyz, Trotta Jr., and Bednarek capturing and sending an image of a product with a camera, because this will provide a convenient means for capturing data of products that the customer is interested in and assure that the information is accurate.

Other relevant art of record

(i) US PG PUB 20020016804 to Walilewski teaches a system for generating a pick list generator that is used to on devices that do not have all the letters and digits of a computer with a keyboard.

(ii) US PG PUB 20020002513 to Chiasson teaches a method for creating an e-catalog template that can be recalled and used to simplify a search..

(iii) US Patent 6,523,061 to Halverson et al teaches the use of agents to produce navigation queries.

(iv) US Patent 5,978,833 to Pashley et al teaches downloading tables for developing search criteria.

Non-Patent Literature

(v) M2Presswire, teaches the use of a mobile device to capture scanned information which can later be used on the mobile device.

Response to Arguments

Applicant's arguments with respect to claims 48-51,53-62 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM**.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including After Final communications labeled "Box AF"]

For general questions the receptionist can be reached at 571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/
Mark Fadok
Primary Examiner, Art Unit 3625